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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER SCHWARTZ, DARREN B				
ART UNIT 2435		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,787

Applicant(s)

KSONTINI ET AL.

Examiner

DARREN SCHWARTZ

Art Unit

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date 08-26-09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant amends claims 1 & 8.

Claims 1-3 & 5-9 are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 October 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-3 & have been considered but are moot in view of the new grounds of rejection.

The Examiner has consulted with Attorney Purohit (#Lo550) on behalf of Attorney Daley (34313). While issues and concerns have been addressed between the Examiner and Attorney Purohit, the Office is required to issue an action on the merits at this time. All documentation, issues and concerns that have been addressed with Attorney Purohit are currently being held in abeyance.

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Applicant's claim of a pairing control method between a first device and a second device does not provide any concrete machine. The mere recitation of "a device" does not relegate the device to hardware and may be construed as software. Applicant's disclosure provides the following: "a first device such as a removable security module and a second device such as a host apparatus, ..." (page 1, lines 22-23). However, as this excerpt implies, it is merely a non-limiting example. Additionally, a "removable security module" may be reasonably construed as security software that can be deleted and a "host apparatus" may be reasonably construed as merely software.

Claim Objections

Claim 8 is objected to because of the following informalities:

Claim 8 recites twice a "management centre" and should read "management center."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the cryptogram being encrypted by a secret key common to **all the first devices**" (emphasis added). While the claim provides for a first device the claim is silent as to a plurality of first devices . There is insufficient antecedent basis for this limitation in the claim.

Any claim not specifically addressed above is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Venkatram et al (U.S. Pat 6367010 B1), hereinafter referred to as Venkatram.

Re claim 1: Venkatram teaches a pairing control method between a first device and a second device, the pairing control method aiming to secure the data exchange with the aid of a unique pairing key, the pairing control method comprising:

verifying the pairing between the two devices and using the unique pairing key when the pairing between the two devices has not been carried (Fig 1, elts 2 → 4 -- Yes→ 14 --Yes→ 12; col 3, lines 49-51; col 4, lines 1-7). The Examiner notes that the prior art need teach only one condition as the claim, as it is currently stated, imposes that only one condition need be met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatram et al (U.S. Pat 6367010 B1), hereinafter referred to as Venkatram, in view of Perlman (U.S. Pat 6975729 B1), hereinafter referred to as Perlman.

Re claim 2: Venkatram teaches all the limitations of claim 1 as previously stated. However, Perlman teaches the unique pairing key is based on the identifier of the second device and on the data of the first device (Fig 4, elts 101, 102, 103, 201, 202, 203 & 104: col 8, lines 27-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Venkatram with the teachings of Perlman, for the purpose of generating various keys and preventing key collisions.

Re claim 3: Venkatram teaches all the limitations of claim 1 as previously stated. However, Perlman teaches the cryptogram is stored in the first device and encrypted with a secret key common to the second devices [Fig 3, elt 306] (Fig 3: elts 302, 303, 306, 308, 310; Abstract, lines 11-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Venkatram with the teachings of

Perlman, for the purpose securing data using a public key cipher. It is well known in the art that public key protection provides for high levels of communications protection.

Re claim 5: Venkatram teaches all the limitations of claim 1 as previously stated. However, Perlman teaches the pairing is conditioned by the introduction of a secret code transmitted to the first device and verified by said first device (Fig 4B: elts 417, 418, 419, 415 & 422: col 5, line 61 – col 6, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Venkatram with the teachings of Perlman, for the purpose of preventing tampering of credentials exchanged between two parties whom do not yet trust each other but must exchange credentials to yield a secure & authenticated communication channel.

Re claim 6: The combination of Venkatram and Perlman teaches the secret code belongs to and is unique to each first device (Perlman: Fig 3, elts 302, 303, 308, 310, 302, 314, 328, 329 & 330).

Re claim 7: The combination of Venkatram and Perlman teaches the required secret code is different in each pairing (Perlman: col 1, lines 50-55).

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatram et al (U.S. Pat 6367010 B1), hereinafter referred to as Venkatram, in view of Perlman (U.S. Pat 6975729 B1), hereinafter referred to as Perlman, in further view of Tello (U.S. Pat 6463537 B1), hereinafter referred to as Tello.

Re claim 8: The combination of Venkatram and Perlman teaches all the limitations of claim 5 as previously stated.

Tello teaches the method further comprising: transmitting a unique identifier of the first device and the unique identifier of the second device to a management centre, verifying the conformity of the pairing and calculating, by means of the management center, a corresponding secret code on the basis of the two identifiers, transmitting the secret code to a user, initiating the pairing and requesting the introduction of the secret code, by means of the first device, calculating by means of the first device the necessary secret code on the basis of the identifiers of the first and second devices, comparing the calculated code with a code introduced by the user, accepting the pairing if the two codes are identical (Fig 1; col 17, line 52 - col 18, line 3; col 18, lines 32-39; col 24, lines 25-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Venkatram and Perlman with the teachings of Tello for the purpose of providing a manager for verifying the two devices are allowed to inter-connect. All references are analogous art as they teach transmission of data from a first device to a second device using device dependant information.

Re claim 9: The combination of Venkatram, Perlman and Tello teaches it comprises the steps of determining the new secret code on the basis of the two identifiers and of an index that represents the number of pairings previously carried out, whereas the first device stores this index in its memory (Venkatram: col 3, lines 60-64)

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./
Examiner, Art Unit 2435
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435